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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,641	12/05/2000	Ching-Chih (Jason) Han	CREO.009US0	9293
25242	7590	07/29/2004	EXAMINER	
VICTOR H. OKUMOTO P.O. BOX 6120 FREMONT, CA 94538			FIELDS, COURTNEY D	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/730,641

Applicant(s)

HAN ET AL.

Examiner

Courtney D. Fields

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3,5,8-14, and 16-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Young et al. (U.S. Patent No. 6,202,150). Referring to the rejection of claims 1 and 10, Young et al. discloses a method and apparatus for providing conditional access to the source code of a program comprising: generating encrypted source code of a program, generating a software key to decrypt the encrypted source code, providing the encrypted source code to a recipient, and providing the software key to an escrow holder who is under instructions to provide the software key to the recipient upon satisfaction of a release condition in Column 6, lines 47-67, Column 2, lines 1-60.

As per claim 2, Young et al. discloses the claimed limitation wherein the software key is randomly generated while generating the encrypted source code in Column 7, lines 61-67, Column 8, lines 1-5.

As per claims 3, 8, 11, 14, 18, and 23, Young et al. discloses the claimed limitation wherein generating binary executable code of the program, and providing the encrypted source code, and the binary executable code of the program to the recipient in Column 8, lines 6-61.

As per claims 5, 9, and 12, Young et al. discloses the claimed limitation wherein the providing of the software key to the escrow holder includes transferring information of the software key along with an identification of the recipient to the escrow holder in Column 10, lines 34-58.

As per claims 13 and 21, Young et al. discloses the claimed limitation wherein a computer that is programmed to generate encrypted source code of the program generate a software key to decrypt the encrypted source code, facilitate providing the encrypted source code to a recipient, and facilitate providing of the software key to an escrow holder who is under instructions to provide the software key to the recipient upon satisfaction of a release condition in Column 7, lines 4-28.

As per claim 16, Young et al. discloses a method for providing conditional access to the source code of a program comprising: receiving source code of a program, and information identifying a recipient, generating encrypted source code from the source code, generating a software key to decrypt the encrypted source code, and creating a

record including the software key and the information identifying the recipient in Column 9, lines 6-67, Column 10, lines 1-33.

As per claims 17 and 22, Young et al. discloses the claimed limitation wherein providing the encrypted source code to the recipient in Column 5, lines 60-67, Column 6, line 1.

As per claims 19 and 24, Young et al. discloses the claimed limitation wherein receiving information identifying an escrow agreement having release conditions, and the created record further includes the information identifying the escrow agreement in Column 9, lines 66-67, Column 10, lines 1-12.

As per claims 20 and 25, Young et al. discloses the claimed limitation wherein providing the software key to the recipient upon satisfaction of one of the release conditions in Column 7, lines 29-60.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. in view of W. Richard Stevens (TCP/IP, Illustrated, Vol. 1). As per claim 1, Young et al. discloses the invention as claimed above. However, as per claim 4, Young et al. does not specifically disclose providing the source and binary codes over the Internet using file transfer protocol (FTP). As per claim 4, Stevens teaches FTP is commonly used to transfer files from one system to another. (See page 419) Therefore, it would

have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Steven's teachings of file transfer protocol (FTP) with Young's auto-escrowable and auto-certifiable cryptosystem. In order to gain the benefits of a protocol that works between different systems, by supporting a number of files types and file structures between the varied systems. (See Stevens, page 419)

5. Claims 6-7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. in view of Sudia (U.S. Patent No. 5,799,086). As per claim 1, Young et al. discloses the invention as claimed above. However, as per claims 6-7 and 15 Young et al. does not specifically disclose providing the key to the escrow holder by email. As per claims 6,7, and 15, Sudia discloses the claimed limitation wherein the providing of the software key to the escrow holder includes emailing the software key to the escrow holder in Column 40, lines 24-67, Column 41, lines 1-6. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Sudia's enhanced cryptographic system with a key escrow feature with Young's auto-escrowable and auto-certifiable cryptosystem. Sudia's teaching of a cryptographic system with a key escrow wherein a key is provided to the escrow holder (CA) via email during registration allows the trusted device to communicate with other trusted devices. (See Sudia, Abstract)

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Y. Desmedt, "Securing Traceability of Ciphertexts-Towards a

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Secure Software Key Escrow System", Eurocrypt '95, pp.147-157, Springer-Verlag, 1998 discloses a method which allows traceability of ciphertext to be tamperproof.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney D. Fields whose telephone number is 703-305-8293. The examiner can normally be reached on Mon - Wed. 6:00 - 6:00 pm; Thur. 6:00 - 10 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 703-306-3036. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*cdf*

cdf  
July 22, 2004

*Matthew Smithers*  
**MATTHEW SMITHERS**  
**PRIMARY EXAMINER**  
*Art Unit 2137*